UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JONATHAN EDWARDS, EDMUND WHITE and SHAWNA TURNER

Appeal No. 2006-1665
Application No. 09/823,438

ON BRIEF

Before BARRY, SAADAT, and MACDONALD, Administrative Patent Judges.

SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-5, 7-11, 17-23, 25-29, 35-41, 43-47 and 53-59. Claims 6, 12-16, 24, 30-34, 42, 48-52 and 60 have been canceled.

We reverse.

BACKGROUND

Appellants' invention is directed to a method and system for scanning data for virus wherein a scanner thread determines whether the object of interest needs scanning. If all of the available scanner threads are overwhelmed with scan requests, the system may delay accessing the files and slow down the process. According to Appellants, using a pool of pre-processor threads and a priority queue before the requests are received in the scanner thread improves the efficiency with which the scanner threads process scan requests.

Representative independent claim 1 is reproduced below:

1. A method for prioritizing virus scan requests comprising:

checking a virus scan request to determine if scanning an object of the request is necessary; and

placing the virus scan request on a queue in a priority order based on a characteristic of the virus scan request, the characteristic including at least one of an identity of the user triggering the virus scan request, a type of the process accessing the object, a time stamp of when the virus request was received, and an indication of a network node accessing the object, wherein the virus scan request is prioritized based on at least one of the user identity being an administrator as compared to a regular user, the process type being an operating system as compared to a user applicant, the time stamp being earlier than the time stamps of each scan request previously placed on the queue, and the indication being that the object is accessed from a server console as compared to a network client.

The Examiner relies on the following references in rejecting the claims:

U.S. Patents

Wong	5,974,465	Oct. 26, 1999
Chess et al. (Chess)	6,560,632	May 6, 2003 (filed Jul. 16, 1999)

Other Publications

"Reserved-Checkout for Versioned Object" (IBM), IBM Technical Disclosure Bulletin 521 (1993).

McAfee Virus Scan for Windows 3.x" (McAfee), University of East Anglia 1 (1997).

"Chapter Thirteen Performance Tuning" (performance), <http://www.mtsac.edu/vzamora/cis19/chap13.htm> (2000).

"Using Netware 3.12" (Netware), <http://www.et.utt.ro/public/Docs/special%20Edition%20Using%20Netware%203.12/ch18.html> 1 (2000).

Claims 1-11, 17, 19-23, 25-29 and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chess and Wong.

Claims 18 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chess and Wong in combination with McAfee.

Claims 37-41 and 43-53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chess and Wong in combination with IBM.

Claim 54 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chess, Wong and IBM in combination with McAfee.

Claims 55-59 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chess, Wong and IBM in combination with Performance.

Rather than reiterate the opposing arguments, reference is made to the briefs and answer for the respective positions of Appellants and the Examiner.

OPINION

The initial burden of establishing reasons for unpatentability rests on the Examiner. In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). The Examiner must produce a factual basis supported by teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration, consistent with the holding in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966). Our reviewing court requires this evidence in order to establish a prima facie case.

In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984); In re Cofer, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966). However, "the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

The focus of Appellants' argument is that Chess merely classifies queries or files that are already queued whereas the claims require placing virus scan requests on a queue based on the characteristics of the scan requests (brief, page 10). The Examiner responds by stating that Chess first determines (col. 5, lines 38-44) if scanning an object is necessary and then, prioritizes requests (col. 3, lines 14-20 and 42-56) while queuing a file to be analyzed is equivalent to queuing a request that the file be scanned (answer, page 13). Appellants respond by asserting that the files in Chess are not the same as a request and cannot be characterized as both the file to be scanned and the request for scanning (reply brief, pages 2-3).

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the Examiner's decision on appeal, the Board must necessarily weigh all of the evidence and argument." In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In this case, as discussed by Appellants, the portions of Chess relied on by the Examiner (answer, pages 13-14) merely describe prioritizing the queued units of digital data for transmission to a next node (col. 3, lines 9-23) instead of queuing the virus scan requests. In that regard, the queued items of Chess are the units of data which including queries or files which are suspected of having the malicious codes or virus and are later scanned (col. 3, lines 42-47).

Therefore, we do not agree with the Examiner's position (answer, page 13) equating placing a file to be analyzed on a queue with queuing a request that the file be scanned. In Chess, the queued files are the objects to be scanned and the criteria for queuing them relates to the type of the object contained in the files to be scanned (col. 3, lines 53-56). As such, contrary to the Examiner's assertion (answer, page 14), classifying the

files based on the type of digital object they contain (col. 6, lines 58-63) cannot be the same as the claimed queuing the requests based on a characteristic of the virus scan requests. Thus, assuming, arguendo, that it would have been obvious to combine Chess and Wong, as held by the Examiner, the combination would still fall short of teaching or suggesting the claimed placing the requests on a queue in a priority order based on a characteristic of the request, as recited in independent claims 1 and 19. Accordingly, based on the weight of the evidence and the arguments presented by the Examiner and Appellants, we do not sustain the 35 U.S.C. § 103 rejection of claims 1-11, 17, 19-23, 25-29 and 35 over Chess and Wong.

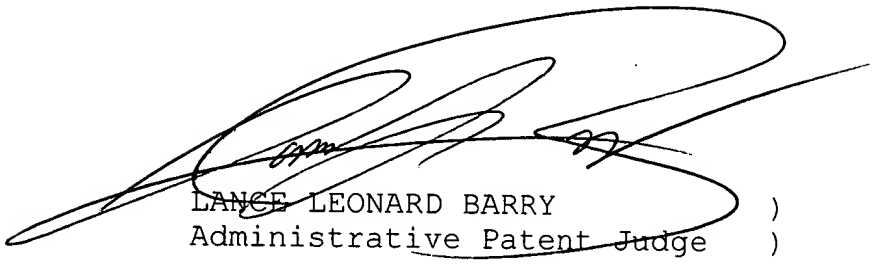
Turning now to the 35 U.S.C. § 103 rejection of the remaining claims, we note that the Examiner further relies on other references in addition to Chess and Wong. However, the Examiner has not pointed to any disclosure in these references that may relate to the recited queuing of the requests for scan based on the characteristics of the requests and overcome the

deficiencies of Chess and Wong as discussed above with respect to claims 1 and 19. Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of claims 18 and 36 over Chess, Wong and McAfee and of claims 37-41 and 43-53 over Chess, Wong and IBM. Similarly and for the same reasons, the 35 U.S.C. § 103 rejection of claim 54 over Chess, Wong, IBM and McAfee and of claims 55-59 over Chess, Wong, IBM and Performance cannot be sustained.

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-5, 7-11, 17-23, 25-29, 35-41, 43-47 and 53-59 under 35 U.S.C. § 103 is reversed.

REVERSED



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Administrative Patent Judge)
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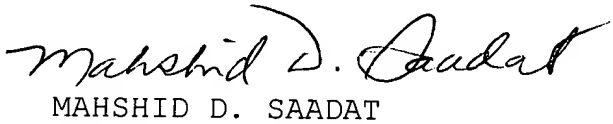
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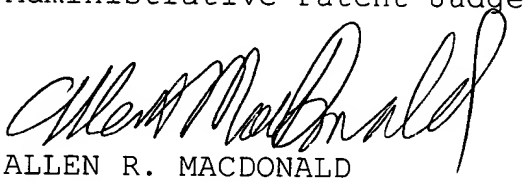
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